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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 09/613,425 | 07/10/2000 | Robert A. Gelman | P18732 | 9346 |
| 7055 | 7590 | 12/20/2005 | EXAMINER | |
| GREENBLUM & BERNSTEIN, P.L.C. 1950 ROLAND CLARKE PLACE RESTON, VA 20191 | | | ACQUAH, SAMUEL A | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 1711 | |
| DATE MAILED: 12/20/2005 | | | | |

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/613,425

Applicant(s)

GELMAN ET AL.

Examiner

SAMUEL A. ACQUAH

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 October 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) See Continuation Sheet is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6, 8-11, 15, 16, 18, 19, 21-56, 58-71, 77-82, 84-86, 88-106, 108-115, 117, and 118 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Continuation of Disposition of Claims: Claims pending in the application are 1-6,8-11,15,16,18,19,21-56,58-71,77-82,84-86,88-106,108-115,117 and 118.

DETAILED ACTION

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

2. Applicant's arguments filed 10/12/05 have been fully considered but they are not persuasive. See the explanations below.

3. Claims 1-6, 8-11, 15, 16, 18, 19, 21-56, 58-71, 77-82, 84-86, 88-106, 108-115, 117, and 118 are rejected under 35 U.S.C. 103(a) as being unpatentable over Suzuki et al 6,698,305.

The reasons for the rejections are essentially as explained in the previous communication. Applicants take the position that the prior art is different because the prior art adds the sizing agents or moisture barrier compound to the newsprint base paper and not to the coating composition. It is the Examiner's position that Applicants' argument is not convincing. At the outset, it is important to ask whether the prior art recognizes the problem that Applicants attempt to solve, which is to provide a coating composition for coating substrates wherein said coating composition has a tendency to avoid moisture or water vapor. In this regard, Applicants' attention is directed to column 2, line 17 et seq., wherein patentees discuss the problems "blocking trouble" and coating lightweight newspaper, and some of the attempts that have been made to solve this problem and to improve the surface strength, stickiness, and peeling strength, as well as achieving a balance between these properties. Patentees indicated that some of the efforts have included adding fluorine compounds and substituted succinic acid and/or a substituted succinic acid derivatives in the coating compositions, especially

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where the paper is to be used in offset printing as claimed herein. Also, attention is directed to column 10, line 8 et seq., wherein patentees teach that as necessary, the base paper may contain various additives including paper strength agents, reactive sizing agents such as AKD, alkenylsuccinic anhydride, water resistant agents, emulsion sizing agents, antifoaming agents, etc., such that the paper may be printed by offset printing. Attention is further directed to column 11, line 13 et seq., wherein patentees teach that “Since, in general, newsprint base paper contains large amounts of mechanical pulp, it is very high in water absorptivity. Therefore, coating color such as surface treating agent is liable to penetrate into the paper, and it difficult to evenly coat a small coating amount” (emphasis added). Thus, Patentees clearly recognize the need to exclude moisture when using an agent comprising components A) and B) to coat a substrate. Thus, it is the Examiner’s position that one of ordinary skill in the art would have been sufficiently motivated to add a moisture barrier agent either to the base paper or to the coating agent composition for the art recognized benefit of excluding water moisture or providing barrier properties as claimed.

As indicated in the previous communication, the use of the composition to coat any other substrate is well within the level of skills of the ordinary practitioner.

4. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to SAMUEL A. ACQUAH whose telephone number is 571-272-1065. The examiner can normally be reached on M-TH, FRIDAYS OFF.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, JAMES SEIDLECK can be reached on 571-272-1078. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

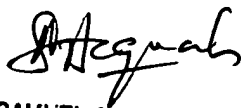
S.A.A.

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12/12/05


SAMUEL A. ACQUAH
PRIMARY EXAMINER
GROUP ~~1200~~ 1200